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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,030	07/18/2003	Kimberly D. Anderson	19691 (27839-1314)	4469
45736 7590 05/15/2009 Christopher M. Goff (27839) ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST. LOUIS, MO 63102				
EXAMINER KIDWELL, MICHELE M				
ART UNIT 3761		PAPER NUMBER		
NOTIFICATION DATE 05/15/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

### Office Action Summary

**Application No.**

10/623,030

**Applicant(s)**

ANDERSON ET AL.

**Examiner**

Michele Kidwell

**Art Unit**

3761

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 2/25/09/3/27/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 23, 2009 has been entered.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13, 15-18 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeo (US 5,503,076) in view of Dispoto et al. (US 4,680,645).

Regarding claims 1-3, 15, and 17-18: Yeo discloses a multi-color printed nonwoven web laminate 10 or any other type of substrate layer (column 4, lines 8-11, column 5, lines 29-34) for use in an outer cover of absorbent personal care products such as diapers and incontinence garments (column 1, lines 12-14 and column 7, lines 52-57) comprising a fibrous, absorbent facing layer/overlay 12 and substrate layer/additional other component 14, and an image including at least one ink having the color of red, blue, and green 16a, 16b, 16c and

inherently black [Note that the primary colors red, blue, green when mixed form black] as set forth in column 4, lines 8-16 and figure 1

While, Yeo discloses the image being printed in a non-contact manner via flexographic or ink-jet printing for good print pattern definition (column 8, lines 49-52) and the laminate in one embodiment being printed at a line speed of approximately 100 feet per minute (column 10, lines 39-42), the examiner contends that the manner in which the image is printed (i.e. a non contact manner) is considered as a product by process limitation that does not provide a patentable distinction between the claimed invention and the prior art.

Yeo does not expressly disclose the specific colored inks in a specific coverage percentage area values. However, Yeo does allow for the pigment to be used in the claimed range as set forth in col. 2, lines 59 – 60.

Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yeo with the desired colors in the desired coverage ratio since the general concept of providing pigmentation in the claim range has been established by the Yeo.

Yeo further does not expressly disclose an image resolution of 100 dpi.

Dispoto discloses images on paper made with a resolution of 100 dpi resulting in an excellent quality image free of image artifacts (column 1, lines 6-10, column 2, lines 53-64).

One would be motivated to modify the image of Yeo to have the resolution of Dispoto for an excellent quality image since the references disclose printing images on

substrates. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the article image, thus providing a resolution of 100 dpi.

Regarding claims 4-7: Yeo further discloses the facing layer/outer cover 12 comprises a white background (which inherently is formed via the loading of fibers with titanium dioxide which produces a white color) on which an image such as stars and hearts is printed (column 5, lines 12-16 and figures 1 and 3).

Regarding claims 8-9 Yeo further discloses the .image includes a separable design element having a periphery and interior, the interior being free of black ink shading and the design element outlined in black ink (figure 3).

Regarding claim 10 Yeo further discloses the image being printed in a non- contact manner via flexographic or ink-jet printing for good print pattern definition as discussed above with respect to claim 1, the image inherently being printed with the highest threshold of blank ink in order to maximize the image quality.

Regarding claims 11-12 Yeo further discloses a focal element 16b for example (figure 1). Yeo/Dispoto does not expressly disclose the dimensions of the design elements.

The design elements are result effective variables since they are a result of the number of designs placed on the substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yeo/Dispoto with design elements dimensions, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch and Slaney, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 13 Yeo discloses water-based inks that may include wax additives (column 6, lines 53-60 and column 7, lines 39-44).

Regarding claim 16 Yeo/Dispoto do not expressly disclose a color difference value (DE\*). Color difference is a result effective variable since it is dependent on the change in lightness and change in chroma as disclosed by Applicant (page 21, paragraph 0049). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yeo/Dispoto with the color difference values for optimum image performance, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch and Slaney, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, when the reference discloses all the limitations of a claim except a property or function (i.e.: does not expressly disclose the color difference values), and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02.

Regarding claim 33 see the discussion above with respect to claims 1 and 16.

Regarding claims 34 – 36 see col. 4, lines 8 – 22 and col. 8, line 66 to col. 9, line 10. The examiner notes that the manner in which the ink is applied is considered functional. Yeo discloses the use of ink jet printing as does the applicant. In light of such, the examiner contends that the device of Yeo is fully capable of performing the recited function.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yeo (US 5,503,076) in view of Dispoto et al. (US 4,680,645), and further in view of Schleinz et al. (US 5,612,118).

Yeo/Dispoto do not expressly disclose the outer cover material that is the printing substrate is made of an extensible material.

Schleinz discloses absorbent training pant 20 with absorbent at crotch section, liquid permeable liner and elastic outer cover 42 for improved elasticity throughout the pant body, the outer cover having an outer surface 44 with a plurality of printed graphics 46 thereon (column 3, lines 52-58, column 4, lines 21-23, figure 1).

One would be motivated to modify the outer cover of Yeo/Dispoto with the extensible outer cover of Schleinz for improved elasticity throughout the pant body since both references disclose disposable absorbent articles having graphics printed on the outer cover.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the outer cover, thus providing an elastic and extensible outer cover.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 – 18 and 33 – 36 have been fully reconsidered but they are not persuasive.

The applicant's arguments filed February 23, 2009 are found non persuasive because the applicant's arguments are directed toward functional limitations. The applicant is reminded that a recitation of the intended use of the claimed invention must

result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Likewise, the applicant argues the coverage area ratios, however, these ratios occur under specific conditions (i.e., when a specific color is present and/or is applied at a maximum threshold). As previously discussed, both the instant application and the reference disclose the use of ink jet printing to apply the image and therefore, one could reasonably presume that the disclosure of Yeo would be fully capable of performing the recited function. Further, the contention that any image in the area may be compared to any and/or all other portions of the article in order to meet the claimed limitation is still applicable to the claims as amended.

It is further noted that Yeo provides pigmentation in the claimed range as set forth in col. 2, lines 59 - 60. As only one color is needed to meet the claimed limitation, the disclosure may be considered to read on the claimed language. Notwithstanding, the modification of the color and corresponding coverage configurations is considered to be within the level of ordinary skill in the art.

Regarding applicant's statement of information listed in the specification, the applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Likewise, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences



would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The applicant discloses that ink jet printing produces the claimed results. Similarly, Yeo discloses the use of ink jet printing for applying images to substrates. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. See MPEP 2112.02.

The examiner maintains the rejection of claims 11 – 12 as the design elements and the subsequent dimensions are a direct result of the number of designs placed on the substrate and/or the type of garment being produced. In light of such, the dimensions may be considered as result effective variables and would be obvious to modify based on the intended use of the product.

As to the applicant's remarks regarding uniform dot sizes, the examiner contends that the claimed limitations are functional; however, the applicant's remarks do not appear to be commensurate with the scope of the claims. The claim requires the dots as a whole to produce a uniform volume of ink. As discussed by applicant, Dispoto seeks to correct areas in gray-scaling which, in turn, produces a more uniform product. In turn, the examiner contends that the dots of Dispoto as a whole provide a uniform volume of ink.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele Kidwell/  
Primary Examiner, Art Unit 3761